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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,817	08/05/1999	SHARON R. GARBER	54419US1B014	5974

32692 7590 09/10/2003

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EXAMINER
KIM, AHSHIK

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/368,817	GARBER ET AL.	
	Examiner	Art Unit	
	Ahshik Kim	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05/13/03 (Amendment)* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,20-23,26-35 and 40-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,20-23,26-35 and 40-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *24* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on May 13, 2003. In the amendment, 7-16, 19, 24, 25, and 36-39 were canceled, and claim 40 was amended. Currently, claims 1-6, 20-23, 26-35, and 40-43 remain for examination. In the introductory remarks, the Applicants stated that the amendment is in response to Office Action, paper number 28, mailed December 18, 2002. The Examiner notes that the Office Action mailed on December 18, 2002 is paper #23.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 26-29, and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowers et al. (US 5,963,134, cited by the applicant, "Bowers" hereinafter).

Re claims 1-6, Bowers discloses an RFID device comprising an interrogator [42, 43] for obtaining information from an RFID element 54 associated with an item 22 wherein the device is portable and adapted for carriage and hands-free use by a person (abs., lines 1+; col. 6, lines 38-42; col. 8, lines 1+; col. 9, lines 34+); an indicator for indicating information regarding one or both a class of materials (i.e., KA-452-11001, etc.) to which the item 54 belongs, and a desired

both a class of materials (i.e., KA-452-11001, etc.) to which the item 54 belongs, and a desired location (i.e., main, engineering, etc.) for that item 54 wherein the indicator provides at least one of an audible and a visual indication (figs. 4 & 7; col. 7, lines 65-67; col. 10, lines 35+); wherein the information is obtained from memory within the RFID device (figs. 1 & 3; col. 9, lines 15-36); wherein the information is obtained from memory separate from the RFID device by upload (col. 10, lines 44+); wherein the information is obtained from the tag on the item (fig. 2; col. 8, lines 35-53).

Re claims 26-29, and 34-35: Bowers discloses a method of using an RFID device for identifying and locating items having an RFID element 54 associated therewith; comprising providing information to the RFID device 42 identifying a location; interrogating the items 22 with the REID device 42 to determine the identity of the items 22; associating the items with the location; interrogating an RFID element: 54 associated with a location; arranging and interrogating the items 22 in a series [KA-452-11001, KA-456-11221, etc.] so that the REID device 42 can determine the location of one item with respect to other items; displaying the items and their respective locations; and downloading the information associating the items with the location to a computer 48, wherein the items are library materials (figs. 1 & 4; col. 9, line 41 through col. 10, line 21; col. 8, lines 50-56; and col. 11, lines 57-65).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers. The teachings of Bowers have been discussed above.

Re claims 20-22, Bowers discloses a method of using an RFID device comprising the steps of interrogating an item 22 having an RFID element 54 associated therewith; determining whether the interrogated item 22 belongs at the location; providing a signal; and wherein the item 22 is a library material and the location is a library storage location (col. 12, lines 3-23; col. 15, line 42 - col. 16, line 39).

Bowers fails to teach or fairly suggest the step of inputting information to the device to describe a location wherein the location has a separate RFID element and step of scanning the RFID element associated with that location.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a separate RFID element associated with each separated location (e.g., each individual shelf, room, etc.) into the library system as taught by Bowers in order to provide Bowers with a time consuming system wherein a miss-located or miss-shelved

item/article can be determined readily based on the information of the location and the information of the item's location read from the RFID tags. Furthermore, such modification would have been an obvious extension as taught by Bowers, and therefore an obvious expedient.

Re claim 23, Bowers discloses a method of using a handheld RFID device 42 for reading information from an RFID element comprising the steps of interrogating the RFID tags 54 associated with each of a group of items 22, detecting the miss-located/miss-shelved item and providing an indication to the user of that location (col. 16, lines 1+).

Bowers fails to specifically teach or fairly suggest that the system detecting where within the group of items a desired item should be placed.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the above capability into the library as taught by Bowers in order to provide Bowers with a more user-friendly system wherein a desired item's location being provided to the user readily, thus reduce labor in the finding process. Furthermore, such modification would have been an obvious extension as taught by Bowers, and therefore an obvious expedient.

7. Claims 30 and 32-33 acre rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Frich (US 6,074,11.56). The teachings of Bowers have been discussed above.

Bowers has been discussed above but fails to teach or fairly suggest that the location is a cart and the method further comprising passing the RFID device into the cart, and wherein the location includes a shelf having an antenna associated therewith.

Frich teaches the above limitation with book cart 200 having titling mean 300 in fig. 1; col. 3, line 38 through col. 4, line 41; especially col. 4, lines 34-41.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Frich into the teachings of Bowers in order to provide Bowers a more accurate system, wherein the operator can only identify and locate items that are shelved but also can find items that are awaited for shelving (i.e., the returning/new items being placed on the cart(s) before moving to their respective shelving locations, etc.). Furthermore, such modification would help the operator to locate and find the desired item readily by providing him/her with the exact location of the desired item, and thus a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Bowers, well within the ordinary skill in the art, and therefore an obvious expedient.

8. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers as modified by Frich as applied to claim 26 above, and further in view of Ghaffari et al. (US 5,708,423, cited by the applicant, "Ghaffari" hereinafter). The teachings of Bowers as modified by Frich have been discussed above.

Re claim 31, Bowers as modified by Frich have been discussed above but fails to teach or fairly suggest that the method further comprising the step of passing the cart through a tunnel.

Ghaffari teaches the above limitation with tunnel 84 in fig. 4; col. 6, lines 27-57.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ghaffan into the teachings of Bowers/Frich in order to provide Bowers/Frich with a quicker and easier way of determining items' location without checking each and every item individually. Furthermore, such modification would provide Bowers/Frich with a more user-friendly system by saving time and requiring less

arduous labor. Accordingly, such modification would have been an obvious extension as taught by Bowers/Frich, well within the ordinary skill in the art, and therefore an obvious expedient.

9. Claims 40 and 41 are rejected under 35 U.S.C. 103(x) as being unpatentable over Sone (US 2002/0,035,560 Al) in view of Cannon et al. (EP 0,794,507 A2, "Canon" hereinafter).

Re claims 40 and 41, Sone discloses a method of displaying related information of an item of interest among a larger group of items comprising the steps of providing a card 20 having an RFID element; transmitting information to the card 20 and storing that information in the RFID element (page 3, paragraph [0033] through page 4, paragraph [0036]); positioning RFID card readers 22 at positions near the item of interest; interrogating the RFID card 20 with the RFID card reader 22; and providing an indicator (display 12) of the information related to the item of interest (fig. 2; page 3, paragraph [0032]).

Sone fails to teach or fairly suggest that the system is applied for locating an item of interest and the information providing of the visual display is the location of the item of interest relative to the location of the RFID.

Cannon teaches the above limitation with an interrogator 20 having a display 22 for displaying the location of an item of interest associated with an electronic/RF tag 15 (figs. 1-6; col. 2, line 28 through col. 4, line 52; and col. 5, line 58 through col. 6, line 41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cannon into the teachings of Sone in order to provide Sone with a time consuming system wherein the location of the item of interest being displayed which leading the customer to his/her desired item readily, thus improving customer's

satisfaction and increasing business. Furthermore, such modification would have been an obvious extension as taught by Sone, and therefore an obvious expedient.

10. Claim 42 is rejected tinder 35 U.S.C. 103(a) as being unpatentable over Sone as modified by Cannon as applied to claim 40, and further in view of Marsh et al. (EP 0,494,114, cited by the applicant, "Marsh" hereinafter). The teachings of Sone as modified by Cannon have been discussed above.

Re claim 42, Sone/Cannon have been discussed above but fails to teach or fairly suggest that the visual display comprising a map of the area including the item.

Marsh teaches the above limitation with a map being generated on the display in col. 7, lines 9-13.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Marsh into the teachings of Sone/Cannon in order to provide Sone/Cannon with a more high tech system, wherein the operator/user is provide with all of the necessary information in the clearest way (i.e., the map direction) of the sought item/object, through which the operator will find the ease in identifying and locating the item/object, and thus providing a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Sone/Cannon, well within the ordinary skill in the art, and therefore an obvious expedient.

11. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sone as modified by Cannon as applied to claim 40, and further in view of Bowers. The teachings of Sone as modified by Cannon have been discussed above.

Re claim 43, Sone/Cannon has been discussed above but fails to teach or fairly suggest that the item of interest is a library material, and the larger group of items comprise other library materials.

Bowers teaches the above limitation with an RFID associated with the library card, the item of interest is a library material, and the larger group of items comprise other library materials (i.e., books, magazines, video and audio tapes, etc.) (col. 3, lines 16+; col. 6, lines 43+ and col. 12, lines 24+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the library system as taught by Bowers into the teachings of Sone/Cannon in order to improve the library system wherein the desired materials can be found and checked out readily. Furthermore, such modification would have mere been a substitutions of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

Response to Arguments

12. The Applicant's amendments and arguments filed on May 19, 2003 have been carefully reviewed and considered, but they are not persuasive.

In the remarks (See page 3, under Remarks) Applicants argue that "reference number 54 refers to the RFID tag, not the item". Examiner notes that claim 1 of the instant application recites "obtaining information from an RFID element associated with an item....."

Examiner further notes that RFID tag 54 of Bowers carries identification information – whether it is an identification number or more detailed information (col. 10, lines 22+). Although the database residing on host machine is referred as information storage location, the

extended identification information can certainly be loaded in RFID tag itself (col. 10, lines 35-37). Whether the tag carries just an identification number as opposed to "extended identification information", they are, in the Examiner's opinion, not patentably distinct. Such variation – how much information to carry on RFID tag - is in most case determined by user's preference or particulars of their embodiment.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Bowers, and the secondary references to Frich and others are directed at item tracking system particularly in library embodiment. Accordingly, it is the Examiner's view that one ordinary skill in the art can contemplate modifying/importing desired features of other references to improve overall functionality of checking/locating system disclosed in Bowers.

The Applicants' amended claims and remarks have been given careful considerations, however, it is the Examiner's opinion that the previously cited references still teach the claimed subject matter disclosed in the instant application. Therefore, the Examiner has made this Office Action final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
August 27, 2003

DIANE I. LEE
PRIMARY EXAMINER